IFW 2634

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of	:	**Confirmation No. 1797**
Mitsuaki OSHIMA et al.	:	Docket No. 2000_1309
Serial No. 09/668,068	:	Group Art Unit 2634
Filed September 25, 2000	:	Examiner A. Le
COMMUNICATION SYSTEM	:	**Mail Stop: AMENDMENT**

RESPONSE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

THE COMMISSIONER IS AUTHORIZED TO CHARGE ANY DEFICIENCY IN THE FEES FOR THIS PAPER TO DEPOSIT ACCOUNT NO. 23-0975

Sir:

This paper is in response to the Office Action mailed January 12, 2005, the period for responding to which being extended by one month to May 12, 2005.

The status of the claims is as follows: 1-18 are canceled and 19-24 are pending.

Claims 19-24 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 19-24 of copending application 09/672,948 in view of claims 19-24 of copending application 09/677,420 and Ooi. This rejection is traversed.

In the provisional obviousness-type double patenting rejection, the Examiner asserts that the "patented claims, taken collectively, disclose all the subject matters claimed in the instant application, except for 'the synchronization data being unique words.'" The Examiner then relies on Ooi as teaching that the use of "words being unique and distinctive" as synchronization data was well-known in the art at the time of invention.

It is improper to modify or combine one of applicants' inventions with another of applicants' inventions in an obviousness-type double patenting rejection. "A double patenting rejection of the obviousness type is 'analogous to [a failure to meet] the nonobviousness requirement of 35 U.S.C.

103' except that the patent principally underlying the double patenting rejection is not considered prior art" (emphasis added). MPEP 804(II)(B)(1) quoting In re Braithwaite, 379 F.2d 594, 154 USPQ 29 (CCPA 1967). In the Braithwaite case, Braithwaite's application claims were rejected under obviousness-type double patenting as being unpatentable over an earlier Braithwaite patent in view of a prior art reference Calingaert. Id at 600. The court pointed out that in the obviousness-type double patenting rejection, "the Braithwaite patent is not prior art and Calingaert is." Id. The court stated that an obviousness-type double patenting rejection is "on the ground that the difference between what is claimed here and what is claimed in the patent to Braithwaite is only such a difference or modification as would be obvious to those of ordinary skill in the art in view of the prior art." Id.

Thus, it is clear that a proper provisional double-patenting rejection should set forth that the difference between what is claimed in the instant application and what is claimed in the copending application is only such a difference or modification as would be obvious to those of ordinary skill in the art in view of the prior art. However, the Examiner has not set forth such grounds. Rather, the Examiner has combined Applicants' invention claimed in application 09/672,948, which is not prior art, with Applicants' invention claimed in application 09/677,420, which is also not prior art. It is improper for the Examiner to rely on Applicants' invention claimed in application 09/677,420 to attempt to show that the difference between the claims of the instant application and the claims in copending application 09/672,948 is only such a difference or modification as would be obvious to those of ordinary skill in the art because Applicants' invention claimed in application 09/677,420 is not prior art.

In view of the above, it is submitted that the provisional obviousness-type double patenting rejection of claims 19-24 as being unpatentable over claims 19-24 of copending application 09/672,948 in view of claims 19-24 of copending application 09/677,420 and Ooi is improper and should be withdrawn.

As stated in item 3 on page 3 of the Office Action, claims 19-24 are otherwise allowable over the prior art of record. Accordingly, it is submitted that the application is in condition for allowance.

The Examiner is invited to contact the undersigned by telephone to resolve any remaining issues.

Respectfully submitted,

Mitsuaki OSHIMA et al.

By: _____

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